



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/911,476

07/25/2001

Hideaki Miyazaki

1405.1046

3966

21171 7590 04/30/2007

STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

BOVEJA, NAMRATA

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

04/30/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/911,476

Applicant(s)

MIYAZAKI ET AL.

Examiner

Namrata Boveja

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 25-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/25/01 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This office action is in response to communication filed on 12/28/2006.
2. Claims 1-24 are presented for examination. Claims 25-27 have been withdrawn.

#### **Claim Rejections - 35 USC § 112**

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

3. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, since the recitation "character *strings* for displaying," renders the claim indefinite, because it is unclear what the Applicant means by this statement. It is interpreted to mean that instructions regarding how to display information are transmitted. Appropriate correction is required.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4-8, 10-12, 14, 15, and 17-24 are rejected under 102(e) as being anticipated by Walker et al. (Patent Number 6,216,111 hereinafter Walker).

In reference to claims 1, 20, and 24, Walker teaches a select-call administration method, system, and program for administrating calls pertaining to select phone calls between calling terminals and receiving terminals (abstract), the select-call administration method comprising: a step of notifying a receiving terminal *with a notification means* that a call from a calling terminal is a select phone call (*i.e. when the customer answers his phone, he will hear that this call is a 6 minute recorded presentation on credit card life insurance, and if he listens to it, he will get up to \$10 as an immediate credit on his bank credit card. The customer can decide to accept this offer*) (col. 8 lines 46-56); correspondence information (*i.e. the length of the call*) based on receiving-terminal correspondence to a call from a calling terminal (col. 6 lines 66 to col. 7 lines 4 and col. 8 lines 50-53); and a step of acquiring a step of creating point information (*i.e. credits*) based on correspondence information acquired by said correspondence information acquisition means and presenting awards (*i.e. a payment to a credit card or phone bill*) based on said point information (col. 2 lines 24-27 and 33-48, col. 3 lines 19-21, col. 6 lines 27-46 and 65 to col. 7 lines 4, col. 7 lines 21-31, col. 8 lines 19-27 and 50-53, and col. 9 lines 10-13).

5. In reference to claim 4, Walker teaches a select-call administration system characterized by carrying out a voice announcement that a call from a calling terminal is a select call (col. 8 lines 49-53).

6. In reference to claim 5, Walker teaches a select-call administration system wherein said select-call notification means incorporates into a messaging signal and

Art Unit: 3622

transmits message information to the effect that a call from a calling terminal is a select phone call (col. 8 lines 49-56).

7. In reference to claims 6 and 7, Walker teaches a select-call administration system wherein based on the correspondence information said point-award presentation means adds and stores predetermined points (i.e. credits) to a point value set for a receiving terminal having received a call pertaining to a select phone call (col. 2 lines 63-65, col. 3 lines 10-14, col. 5 line 67 to col. 6 lines 6, col. 6 lines 43-46 and lines 65 to col. 7 lines 4, col. 7 lines 21-31, col. 8 lines 19-22 and 50-61, and col. 9 lines 10-13).

8. In reference to claim 8, Walker teaches a select-call administration system wherein based on point information administered by said point information administration means said point-award presentation means discounts fees charged to the receiving terminals (col. 6 lines 66 to col. 7 lines 4, col. 7 lines 21-31, col. 8 lines 19-27 and 50-56, and col. 9 lines 10-13).

9. In reference to claim 10, Walker teaches a select-call administration system wherein based on the correspondence information said point-award presentation means adds predetermined points (i.e. credits) to a point value set for a third party (i.e. credits on the phone bill for answering questions about life insurance) apart from the calling terminals and the receiving terminals (col. 8 lines 19-27).

10. In reference to claim 11, Walker teaches a select-call administration system wherein said point-award presentation means based on the point information charges fees to a calling terminal having transmitted a call pertaining to a select phone call (i.e. the insurance company conducting the survey is charged with \$10 that it applied as a

Art Unit: 3622

credit to the user's credit card or phone bill) (col. 6 lines 65 to col. 7 lines 4, col. 7 lines 21-23 and 27-29, and col. 8 lines 19-27 and 50-53).

11. In reference to claim 12, Walker teaches a select-call administration system wherein the correspondence information is call length of a select call (col. 6 lines 65 to col. 7 lines 4 and col. 7 lines 50-53).

12. In reference to claims 14 and 21, Walker teaches a select-call administration system further comprising point information notification means for reporting, to the calling terminal and the receiving terminal having completed a select phone call, point information created based on the call pertaining to the select call (col. 5 lines 67 to col. 6 lines 2 and col. 6 lines 43-46).

13. In reference to claim 15, Walker teaches a select-call administration system wherein said point information notification means reports the point information via voice announcement (col. 7 lines 21-31 and col. 8 lines 49-56).

14. In reference to claims 17 and 22, Walker teaches a select-call administration system further comprising: point information setting means for presetting points (i.e. credits) added to a point value for a receiving terminal when in response to a call from a calling terminal a select phone call has taken place (col. 6 lines 66 to col. 7 lines 4, col. 7 lines 21-31, and col. 8 lines 49-56); point prior-notification means for receiving terminal, during issuance of a phone call from a calling terminal, of point information set by said point information setting means (col. 7 lines 21-31, and col. 8 lines 49-56); and receive-call selection means for a receiving terminal to select in

Art Unit: 3622

response to a phone call from a calling terminal whether or not a select phone call takes place (col. 6 lines 16-25 and 47-51 and col. 8 lines 49-56).

15. In reference to claim 18, Walker teaches a select-call administration system wherein said point information setting means accepts points-to-be-issued information issued from the calling terminals (col. 5 line 67 to col. 6 lines 2 and col. 6 lines 43-46).

16. In reference to claims 19 and 23, Walker teaches a select-call administration system wherein said receive-call selection means is provided with: receive-call condition acceptance means for accepting receive-call conditions from the receiving terminals to permit select calls on the receiving terminal end (col. 8 lines 49-56); and receive-call rejection means for comparing with the receive-call conditions points-to-be-issued information issued from a calling terminal and disconnecting a call from the calling terminal (col. 6 lines 47-51).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 2 and 3 are rejected under U.S.C. 103(a) as being unpatentable over Walker in view of Voit et al (Patent Number 5,805,682 hereinafter Voit).

In reference to claim 2, Walker is silent about a select-call notification means that

Art Unit: 3622

displays transmitting-terminal identification information on the receiving terminals. Voit teaches displaying transmitting-terminal identification information on the receiving terminals (abstract, col. 1 lines 20-25, col. 2 lines 17-25, and col. 6 lines 7-20). It would have been obvious to modify Walker to display transmitting-terminal identification information on the receiving terminals in order to give the recipient an option of knowing who is calling visually without having to pick up the phone instead of just orally by having to pick up the phone.

18. In reference to claim 3, Walker does not specifically disclose the transmitting-terminal identification information to consist of a telephone number beginning with predetermined numerals established for said phone call. Voit teaches the transmitting-terminal identification information to consist of a telephone number beginning with predetermined numerals established for said phone call (abstract, col. 1 lines 20-25, col. 2 lines 17-25, and col. 6 lines 7-20). It would have been obvious to modify Walker to include in the transmitting-terminal identification information a telephone number beginning with predetermined numerals established for said phone call in order to let the recipient know the number of the calling party in addition to a description of the called party to enable the call recipient to call back the calling party at a later time if deemed necessary.

19. *Claim 9 is rejected under U.S.C. 103(a) as being unpatentable over Walker in view of Storey (Patent Number 5,774,870 hereinafter Storey).*

*In reference to claim 9, Walker teaches a select-call administration system (abstract). Walker is silent about a select-call administration system wherein said point-*



Art Unit: 3622

award presentation means is provided with a merchandise information table in which point information and product information are corresponded; and where the *user is prompted at the receiving terminal to select* desired merchandise from the merchandise information table.

*Storey teaches providing a point-award presentation means with a merchandise information table in which point information and product information are corresponded; and where the user is prompted at the receiving terminal to select desired merchandise from the information table (abstract, col. 8 lines 3-64 and col. 9 lines 6 to col. 10 lines 6). It would have been obvious to modify Walker to include providing a point-award presentation means with a merchandise information table in which point information and product information are corresponded; and where the user is prompted at the receiving terminal to select desired merchandise from the information table to offer the recipient the option to redeem credits for other awards than just a monetary credit to his account.*

20. Claims 13 and 16 are rejected under U.S.C. 103(a) as being unpatentable over Walker in view of Official Notice.

In reference to claim 13, Walker is silent about a select-call administration system wherein the correspondence information is operational information pertaining to operational content in the receiving terminals.

Official Notice is taken that it is old and well known to determine operational information pertaining to operational content in the receiving terminals such the operating system on a computer in order to ensure that the file that is being sent to the user will be accessible by the user's operating system. Therefore, it would have been

Art Unit: 3622

obvious to one of ordinary skill in the art at the time the invention was made to include determining the operational information pertaining to the operational content in the receiving terminals in determining the correspondence information to ensure that the information being sent to the recipient for display will be visible to the recipient.

21. **Disclaimer:** Claim 16 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 16, Walker is silent about a select-call administration system wherein said point information notification means transmits character *strings* (i.e. display instructions) for displaying the point information on display devices on the calling terminals and the receiving terminals.

Official Notice is taken that it is old and well known to include display instructions for displaying point information on display devices on user terminals such as done by airline rewards websites to display mileage required for a domestic flight, an international flight, an upgrade, or free beverages. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include display instructions for displaying point information on display devices on user terminals to enable the users to visually see how much credit the user will be receiving for his participation in a given call.

### **Response to Arguments**

22. After careful review of Applicant's remarks/arguments filed on 12/28/2006, the Applicant's arguments with respect to claims 1-24 have been fully considered but are

Art Unit: 3622

moot in view of the new ground(s) of rejection. Amendments to the claims have both been entered and considered.

23. The previously made U.S.C. 112 rejections for claims 3, 9, and 16 have been removed in view of the Applicant's amendments. However, a new U.S.C. 112 rejection for claim 16 has been introduced as necessitated by the Applicant amendment.

24. In reference to claim 1, the Applicant argues that Walker does not teach "a select-call notification means for notifying a receiving terminal that a call from a calling terminal is a select phone call." Furthermore, the Applicant gives an example of this limitation by stating, "For instance, a voice message could explain, "this phone call is a select phone call, and 1 point will be added for each minute." The user can then decide whether to answer the phone call." The Examiner respectfully disagrees with the Applicant, since Walker teaches this limitation in col. 8 lines 44-56 where "when the customer answers his telephone he hears: "Hello, this is a call from (name of bank); if you'll listen to a 6-minute recorded presentation on credit card life insurance, we'll give you up to \$10 as an immediate credit on your bank credit card." As the recorded sales presentation continues, the customer may answer questions and/or accept the offer in the same manner described above." Therefore, Walker teaches giving a notification that the call is a select call by the use of a message stating the nature of the call before the user agrees to take the select call in exchange for the reward being offered to the user.

25. In reference to claim 9, Applicant properly challenged the Official Notice taken by the Examiner, and the Examiner has produced the documentary evidence to support

Art Unit: 3622

the Official Notice by citing the abstract, col. 8 lines 3-64, and col. 9 lines 6 to col. 10 lines 6 of Storey that teach providing a point-award presentation means with a merchandise information table in which point information and product information are corresponded; and where the user is prompted at the receiving terminal to select desired merchandise from the information table (abstract, col. 8 lines 3-64 and col. 9 lines 6 to col. 10 lines 6). It would have been obvious to modify Walker to include providing a point-award presentation means with a merchandise information table in which point information and product information are corresponded; and where the user is prompted at the receiving terminal to select desired merchandise from the information table to offer the recipient the option to redeem credits for other awards than just a monetary credit to his account.

26. Since the Applicant has failed to traverse the Examiner's assertion of Official Notice for claims 13 and 16, the common knowledge or well known in the art statement is taken to be admitted prior art.

### **Conclusion**

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 3622

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

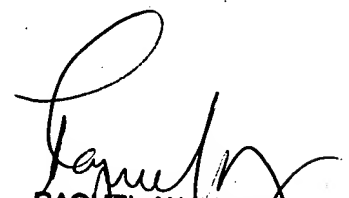
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).



NB

April 16<sup>th</sup>, 2007  
RAQUEL ALVAREZ  
PRIMARY EXAMINER